

Docket No. MCG00309

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Law Department
1303 East Algonquin Road
IL01/3rd Floor
Schaumburg, IL 60196
Telephone: (602) 952-4362
Facsimile: (602) 952-4376

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Subject: 09/997,513

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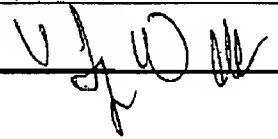
EXAMINER:
GROUP ART UNIT:
SERIAL NO.:
FILED:
INVENTOR:

Stephen M. D Agosta
2683
09/997,513
NOVEMBER 29, 2001
PETER J. ARMBRUSTER ET AL.

TRANSMITTAL FORM	Application Number	09/997,513	
	Filing Date	November 29, 2001	
	First Named Inventor	Peter J. Armbruster et al.	
	Group Art Unit	2683	
	Examiner Name	Stephen M. DAgosta	
Total Number of Pages in this Submission	13	Attorney Docket Number	IR105441

ENCLOSURES			(check all that apply)
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AUG 25 2005

APPLICANT(S)	Peter J. Armbruster	CONFIRMATION NO.:	5018
APPLN. NO.:	09/997,513	EXAMINER:	Stephen M. D Agosta
FILED:	November 29, 2001	GROUP ART UNIT:	2683
DOCKET NO.	IRI05441		
TITLE:	USER CONTROLLED HOME LOCATION REGISTER		

BRIEF ON APPEAL

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Please consider the following Brief on Appeal for the above identified patent application assigned to Motorola, Inc.

I. REAL PARTY IN INTEREST

The subject application is assigned to Motorola, Inc., the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

To Appellant's knowledge, there are no related appeals or interferences.

III. STATUS OF CLAIMS

1. Claims 1-4, 6, 8-18 and 20-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sonti et al. (U.S. Patent No. 6,108,540) in view of Gentry (U.S. Patent No. 6,453,162) in further view of Niepel (U.S. Patent No. 6,671,523).

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2. Claims 5 and 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sonti in view of Gentry and Niepel and in further view of Daniels (U.S. Patent No. 6,058,301)
3. Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Sonti in view of Gentry and Niepel and in further view of Sistanizadeh et al. (U.S. Patent No. 6,681,232).
4. Claim 24 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

IV. STATUS OF AMENDMENTS FILED SUBSEQUENT TO FINAL REJECTION

A response was filed after final rejection and denied entry by the Examiner.

V. SUMMARY OF INVENTION

The present invention pertains to communication subscriber services and more particularly to maintenance and storage of subscriber (user) service profiles.

VI. ISSUES

- (1) Whether claims 1-4, 6, 8-18 and 20-23 are made obvious by Sonti in view of Gentry and Niepel under 35 U.S.C. 103(a).
- (2) Whether claims 5 and 19 are made obvious by Sonti in view of Gentry and Niepel in further view of Daniels under 35 U.S.C. 103(a).
- (3) Whether claim 7 is made obvious by Sonti in view of Gentry and Niepel in further view of Sistanizadeh et al. under 35 U.S.C. 103(a).

VII. GROUPING OF CLAIMS

Appellants offer no other grouping of claims.

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VIII. ARGUMENTS

35 U.S.C. § 103

The Office Action states that claims 1-4, 6, 8-18, and 20-23 are rejected under 35 U.S.C. § 103 for allegedly being unpatentable over U.S. Patent No. 6,108,540 issued to Sonti et al. ("Sonti") in view of U.S. Patent No. 6,453,162 issued to Gentry ("Gentry") in further view of Niepel et al. ("Niepel") (U.S. Patent No. 6,671,523).

The three necessary criteria for establishing a prima facie case of obviousness include 1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings, 2) a reasonable expectation of success, and 3) the prior art reference or references must teach or suggest all the claim limitations.

The Office Action alleges that Sonti teaches the elements of independent claim 1, except for a personal HLR not located with the telecommunication service provider and a link to an operations support system (OSS) of the telecommunication service provider for obtaining services. Additionally, the Office Action alleges that Sonti teaches the elements of independent claim 13, except for a processor means including the HLR, said processor means operating independent of the telecommunications service provider and said processor means coupled to said telecommunications service provider for communication, and the elements of independent claim 21, except for an HLR processor within a particular user and said service provider coupled to said processor means, said network HLR pointing to said personal HLR. The Office Action further alleges that Gentry teaches access to an HLR via the Internet. The Office Action still further alleges that Niepel teaches the aforementioned deficiencies of Sonti and Gentry, specifically equating a SIM card in a mobile phone to an HLR. The Appellants' respectfully disagree.

Sonti teaches a method for allowing subscribers of a telecommunications network to change easily between sets of desired features where a user dials a special code to change a profile containing different set of features for different users of the mobile station or for different times of day or geographic areas. Gentry teaches a method and system for provisioning a wireless component over an internet protocol network where a request to modify information in a

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location register is received from an input device coupled to an internet protocol network, the request is converted into an HLR access message, the HLR access message is sent to the location register, and information is modified in the location register in response to the HLR access message. However, nowhere do Sonti or Gentry disclose a personal home locator register located in a processor of a user, as recited in independent claim 1 and independent claim 21. Additionally, nowhere is there any mention of a processor means including the home location register, said processor means operating independent of the telecommunication service provider and located with a particular subscriber, as recited in independent claim 13. In fact, the Office Action alleges that Sonti teaches a user having access to an HLR function (which contains a processor), but **admits** that Sonti *"does not limit the scope/design of the patent by dictating where certain hardware is located and/or how it must be connected."* However, *Figures 1, 5, 6 and 7 of Sonti clearly teach that HLR (74) is located separately from users, who are at mobile stations (30).* Moreover, Gentry does not mention any processor, let alone a personal home located register located in a processor of a user. In fact, Figure 2 of Gentry clearly teaches and illustrates that HLR is NOT located in a processor of a user, since the user is at a personal computer (48) and HLR (17) is located separately from personal computer (48) across the Internet (46).

The Examiner attempts to remedy the deficiencies of Sonti and Gentry by equating a SIM card in a mobile device to an HLR located in a network in Niepel. It is respectfully pointed out that this allegation is untenable. Niepel teaches a SIM card having a subscriber identity number. Niepel teaches that the identity number is linked to a subscriber profile in the subscriber register (e.g. a home location register (HLR)) (column 1 lines 7-17). *The subscriber profiles are suitably available and can be administered in the network (column 2 lines 1-9).* The Examiner alleges that Figure 2 of Niepel shows a SIM card storing a user profile and attempts to equate this to an HLR. However, a careful reading of Niepel unquestionable shows that the table of Figure 2 of Niepel merely shows the association of a SIM having a subscriber identity number to a user profile, where the table is at the HLR, not in the SIM (column 5 lines 42-53). Furthermore, it is clear in **Figure 1 of Niepel that the HLR is not located with the mobile device (KE)** (column 4 lines 25-49). So it is clear that Niepel teaches an HLR separate from the mobile device and does not teach storing of subscriber profiles in a SIM card, **but merely associating a subscriber identity to a subscriber profile at an HLR in a network.** Therefore, any profiles

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are not stored in the SIM card of Niepel, but in an HLR of the services provider as is found in the prior art. Hence Niepel teaches away from the recited claim limitations.

Further, it is well known, and reiterated in the background section of the present specification, that an HLR stores user profiles (which Niepel does not) and subscription restriction agreements (which Niepel does not even teach let alone teach as being in a SIM card). Therefore, based on the known definition and functionality of an HLR as known by one skilled in the art, it is untenable of the Examiner to allege that the SIM card of Niepel is the same as an HLR. This is especially true since Niepel clearly delineates between an SIM card and an HLR (column 1, lines 10-20). The Appellant's use of the terminology of an HLR is consistent with that as understood by one skilled in the art. Therefore, is abundantly clear that the personal HLR not located with a telecommunication services provider is clear and unambiguous in its meaning, and is decidedly not found in the cited art.

So it is clear that Sonti, Gentry and Niepel teach HLR as being remote from a user. Therefore, Sonti, Gentry and Niepel teach away from Appellant's claims. Teaching away is an important indicium of nonobviousness. U.S. v. Adams, 383 U.S. 39, 148 USPQ 479 (1966). Teaching away is the antithesis of the art suggesting that the person of ordinary skill go in the claimed direction. In re Fine, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988).

Examiner alleges that by Sonti and Gentry not disclosing or limiting where hardware is located, that the personal HLR/database could be located either remotely or with the user. Appellants respectfully disagree. As shown above, both Sonti and Gentry teach that HLR is located separately from a user. Moreover, Appellants DO claim a limitation on the location of HLR - that HLR is located in the processor of a particular subscriber or user (independent claims 1, 13 and 21). It is clear that Niepel does not make up for the deficiencies of Sonti and Gentry, but reinforces those teachings. Even if Sonti and Gentry did not limit the location of the HLR (which Appellants believe they do), it is respectfully pointed out that the Examiner cannot read this limitation into Sonti and Gentry.

The rejection in question can only be based upon a hindsight reconstruction enlightened by Appellant's own disclosure. In other words, even if, as alleged by the Examiner, Sonti, Gentry and Niepel do not teach a particular location of HLR, it is improper hindsight for the Examiner to read the limitations on the location of HLR, as claimed by Appellants, into the teachings of Sonti, Gentry and Niepel.

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Accordingly, as Sonti, Gentry and Niepel fail to disclose, either explicitly or inherently, at least the above-noted elements of claims 1, 13, and 21 and the Examiner has failed to provide such an explicit or inherent disclosure of this element, it is respectfully submitted that the rejection of these claims and the claims that depend therefrom is improper and the Appellants' request withdrawal of the § 103 rejection.

The Office Action states that claims 5 and 19 are rejected under 35 U.S.C. § 103 for allegedly being unpatentable over Sonti and Gentry/ Niepel and in further view of U.S. Patent No. 6,058,301 to Daniels ("Daniels").

Claim 5 depends from claim 1 and claim 19 depends from claim 13. Accordingly, these claims rely on the arguments presented above. Additionally, Daniels does not make up for the deficiencies of Sonti, Gentry and Niepel. Namely, nowhere does Daniels disclose a personal home locator register located in a processor of a user, as recited in newly amended claim 1. Additionally, nowhere is there any mention of a processor means including the home location register, said processor means operating independent of the telecommunication service provider and located with a particular subscriber, as recited in claim 13. Thus, it is respectfully submitted that the rejection of claims 5 and 19 is improper and the Appellants' request withdrawal of the § 103 rejection.

The Office Action states that claim 7 is rejected under 35 U.S.C. § 103 for allegedly being unpatentable over Sonti and Gentry/Niepel and in further view of U.S. Patent No. 6,681,232 to Sistanizadeh ("Sistanizadeh").

Claim 7 depends from claim 1 and relies on the arguments presented above. Additionally, Sistanizadeh does not make up for the deficiencies of Sonti, Gentry and Niepel. Namely, nowhere does Sistanizadeh disclose a personal home locator register located in a processor of a user, as recited in newly amended claim 1. Thus, it is respectfully submitted that the rejection of claim 7 is improper and the Appellants' request withdrawal of the § 103 rejection.

In the Advisory Action dated August 1, 2005, the Examiner indicates that:

- 1) There is no detail as to where the "user processor" is actually located;

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- 2) There is no detail as to what a personal HLR is and/or contains; and
- 3) Absent an amendment of the claims, the Examiner will reject by broadly interpreting Appellant's claims as one database updating another database, unless Appellants' amend to further describe the location of the user processor.

Appellants' respectfully disagree and wish to address the three points above. On the first point, Appellant's independent claims already recite the user processor as being with a user/subscriber and NOT with a telecommunications provider. Appellant's specification and drawings support this, and it has been made clear in numerous responses to Office Actions. Appellants feel that the location of the user processor AND the personal HLR are exceedingly clear and that any further claim language is redundant and unnecessary.

On the second point, as noted above, one skilled in the art knows what an HLR is and Appellant's specification and responses to Office Actions make clear what a personal HLR is comprised of. As stated above, and in Appellant's specification, an HLR stores user profiles and subscription restriction agreements. This is known by one skilled in the art and is more than a mere database or a SIM card that merely provides access to an HLR. A personal HLR is an HLR that resides with the user/subscriber and is independent, and is NOT operated by, a telecommunications provider. None of the art of record teaches or suggests this as argued above.

On the third point, Appellant's believe that a further rejection of the pending claims based on interpreting a personal HLR as a mere database is an undue broad interpretation of Appellant's claims. This is based on the teachings of Appellant's specification and the knowledge of one skilled in the art. It is axiomatic that the claims must be interpreted based on the Appellant's disclosure and that Appellant's do not merely teach a generic database, but a much more specialized personal HLR. Appellants' believe that an attempt by the Examiner to reject the pending claims by adding yet fourth reference to the already tenuous three references in the §103 rejection is unwarranted, untenable and an overbroad reading of Appellant's claims.

Summary

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Appellants therefore pray for the reversal of the final rejection and the allowance of the subject application.

Respectfully submitted,

SEND CORRESPONDENCE TO:

Motorola, Inc.
Law Department

Customer Number 23330

By: Kevin D. Wills

Kevin D. Wills
Attorney of Record
Reg. No.: 43,993
Telephone: 602-952-4399
Fax No.: 602-952-4376

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IX. APPENDIX

1. A distributed home location register (HLR) comprising:
a personal home location register (HLR) located in a processor of a user, but not located with a telecommunication services provider;
an interface to the personal home location register for a user to select services;
and
a link to an operations support system of the telecommunication services provider for obtaining services.
2. The distributed HLR as claimed in claim 1, wherein there is further included:
a network home location register (HLR) coupled to the operations support system of the telecommunications service provider.
3. The distributed HLR as claimed in claim 2, wherein there is further included a plurality of users, each user of the plurality of users having an individual HLR within the network HLR indicating said services which are available to each user.
4. The distributed HLR as claimed in claim 3, wherein the individual HLR for a particular user includes a pointer to the personal HLR.
5. The distributed HLR as claimed in claim 1, wherein there is further included a database for storing roaming information, said database coupled to said operations support system.
6. The distributed HLR as claimed in claim 1, wherein there is included a database for subscription information, said database coupled to said operations support system.
7. The distributed HLR as claimed in claim 1, wherein there is further included other networks coupled to said operations support system, said other networks supplying service level agreement information.

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8. The distributed HLR as claimed in claim 1, wherein said personal home location register includes a computing device.

9. The distributed HLR as claimed in claim 1, wherein said link includes an internet connection of said personal home location register to said operations support system.

10. The distributed HLR as claimed in claim 1, wherein said link includes a wireless connection between said personal home location register and said operations support system.

11. The distributed HLR as claimed in claim 1, wherein said link includes a wire line connection between said personal home location register and said operations support system.

12. The distributed HLR as claimed in claim 1, wherein said interface includes a graphical user interface (GUI).

13. An arrangement for distributing a home location register (HLR) from a telecommunications service provider, said arrangement comprising:

processor means including the home location register, said processor means operating independent of the telecommunication service provider and located with a particular subscriber, and said processor means coupled to said telecommunications service provider for communication; and

database means for storing subscriber information for a plurality of subscribers, said database means coupled to said telecommunication service provider, said telecommunication service provider operating in response to a request from said processor means to obtain said subscriber information for said particular subscriber.

14. The arrangement as claimed in claim 13, wherein there is further included link means for coupling said processor means to said telecommunications service provider.

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15. The arrangement as claimed in claim 14 wherein said link means includes an internet connection.

16. The arrangement as claimed in claim 14 wherein said link means includes a wireless connection.

17. The arrangement as claimed in claim 14 wherein said link means includes a wire line connection.

18. The arrangement as claimed in claim 13, wherein:
said database means includes a database for storing telephone subscription information; and
said particular subscriber inputs a change to the HLR to modify the telephone subscription information of the first database.

19. The arrangement as claimed in claim 13 wherein:
said database means includes a database for storing roaming information; and
said particular subscriber inputs change to the HLR to modify the roaming information within the distributed HLR.

20. The arrangement as claimed in claim 13 wherein the telecommunications service provide includes a network HLR for pointing to the HLR of the processor means.

21. An arrangement for a distributed home location register (HLR) comprising:
a personal home location register (HLR) located within a processor means of a particular user; and
a telecommunications service provider including a network home location register (HLR), said telecommunications service provider coupled to said processor means, said network HLR pointing to said personal HLR.

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22. The arrangement as claimed in claim 21, wherein the user affects changes to the personal HLR via communication between the processor means and the telecommunications service provider.

23. The arrangement as claimed in claim 21, wherein the telecommunications service provider includes a traditional network HLR for other users.

24. The arrangement as claimed in claim 23, wherein:
the particular user is charged a first rate for the personal HLR; and
the other users are charged a second rate for the traditional network HLR.

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